PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit:	3713
Attorney Docket No.:	131523-0002 (New)
Applicant:	Chia Mu SHAO
Invention:	ELECTRONIC DART GAME
Serial No:	09/973,285
Filed:	October 9, 2001
Examiner:	Christina Marks.

Certificate Under 37 CFR 1.8(a)

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on January 7, 2008

Michael S. Gzybowski

BRIEF ON APPEAL

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to Appellant's Notice of Appeal filed November 5, 2007 in connection with the above-identified application, Appellant resubmits the present Brief on Appeal.

REAL PARTY IN INTEREST

Appellant has not assigned this application to any entity. Accordingly the real party in interest is appellant whose name is Chia Mu Shao.

RELATED APPEALS AND INTERFERENCES

There are no related cases involved in any appeal procedures or Interferences.

STATUS OF CLAIMS

Claims 1-11, 14 and 15 are pending in this application. Claims 1-11, 14 and 15 stand under Final Rejection, from which rejection of claims 1-11, 14 and 15 this appeal is taken. Claims 12 and 3 were canceled during the prosecution. There are not other claims in this application.

STATUS OF AMENDMENTS

No Amendment(s) after Final was/were filed by appellants in this application.

SUMMARY OF CLAIMED SUBJECT MATTER

As set forth in independent claim 1, the present invention is directed to an electronic dart game comprising:

a dart (130, Fig. 8, and page 7, lines 9-13);

a dartboard (shown in Fig. 4 and in cross section in Figs. 5-7 and described on page 6, lines 1-4), provided with

a frame (100), formed of a plurality of scoring areas (102) by a plurality of radial spiders (106) and circumferential spiders (104) which are arranged crossly (page 6, lines 1-12);

a main body (110) receiving said dart (130), attached to said frame (110); and

an electronic scoring means (shown in Prior Art Fig. 1) for displaying signals collected from said scoring areas (102);

a plurality of coreless inductance coils (120, shown in perspective in Fig. 4 and cross section in Figs. 5-7) with predetermined turns, provided with said frame (100) and connected to said electronic scoring means through cables (122, Fig. 4, page 6, lines 1-12);

said dart (130) is provided with a magnetic substance (page 7, lines 9-12);

each of said coreless inductance coils (120) is associated with a corresponding one of said scoring areas (102) and defines a scoring signal zone (Fig. 4, page 6, lines 1-5); and

a scoring signal is generated by said dart entering said scoring signal zone, said signal is transmitted to said electronic scoring means (Figs. 5-7, page 8, line 20 through page 9, line 6).

As set forth in independent claim 14 the present invention is directed to an electronic dart game comprising:

a dart (130, Fig. 8, and page 7, lines 9-13);

a dartboard (shown in Fig. 4 and in cross section in Figs. 5-7 and described on page 6, lines 1-4), provided with

a frame (100), formed of a plurality of scoring areas 102 by a plurality of radial spiders 106 and circumferential spiders 104 which are arranged crossly (page 6, lines 1-12);

a main body (110) for receiving said dart (130), attached to said frame (100); and

an electronic scoring means (shown in Prior Art Fig. 1) for displaying signals collected from said scoring areas (102);

a plurality of coreless inductance coils (120, shown in perspective in Fig. 4 and cross section in Figs. 5-7) with predetermined turns, provided with said frame (100) and connected to said electronic scoring means through cables (122, Fig. 4, page 6, lines 1-12);

said dart (130) is provided with a magnetic substance (page 7, lines 9-12);

each of said coreless inductance coils (120) is associated with a corresponding one of said scoring means (102) and defines a scoring signal zone (Fig. 4, page 6, lines 1-5); and

a scoring signal is generated by said dart (130) moving through one of said coreless inductance coils (120), and said signal is transmitted to said electronic scoring means (Figs. 5-7, page 8, line 20 through page 9, line 6).

As set forth in independent claim 15 the present invention is directed to an electronic dart game comprising:

a dart (130, Fig. 8, and page 7, lines 9-13);

a dartboard (shown in Fig. 4 and in cross section in Figs. 5-7 and described on page 6, lines 1-4), provided with

a frame 100, formed of a plurality of scoring areas 102 by a plurality of radial spiders 106 and circumferential spiders 104 which are arranged crossly (page 6, lines 1-12);

a main body (110) for receiving said dart (130), attached to said frame (100); and

an electronic scoring means (shown in Prior Art Fig. 1) for displaying signals collected from said scoring areas (102);

a plurality of coreless inductance coils (120, shown in perspective in Fig. 4 and cross section in Figs. 5-7) with predetermined turns, provided with said frame (100) and connected to said electronic scoring means through cables (122, Fig. 4, page 6, lines 1-12);

said dart (130) is provided with a magnetic substance (page 7, lines 9-12);

each of said coreless inductance coils (120) is associated with a corresponding one of said scoring means (102) and defines a scoring signal zone (Fig. 4, page 6, lines 1-5); and

an electronic field is generated only when said dart (130) moves through said coreless inductance coils (120), and said signal is transmitted to said electronic scoring means (Figs. 5-7, page 8, line 20 through page 9, line 6).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-6, 8-11, 14 and 15 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fuscone et al.

Whether claim 7 is properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fuscone et al. in view of Clark.

ARGUMENT

The rejection of claims 1-6, 8-11, 14 and 15 under 35 U.S.C. §103(a) as being unpatentable over Fuscone et al.

The Examiner has relied upon Fuscone et al. as disclosing:

...an electric dart game comprising a dart (Fig. 1), a dartboard provided with a frame of a plurality of scoring areas by a plurality of radial spiders and circumferential spiders which are arranged crossly (Fig. 2, 7 and 9), with a main body for receiving said dart and attached to said frame, and an electronic scoring means for displaying signals collected from the scoring areas (Fig. 5). Said scoring system uses a plurality of inductance coils (Fig. 1 and page 1, lines 125-129 connected to the electronic scoring system (Fig. 5). Fuscone discloses said dart is made of, thus provided with, a magnetic substance (page 1, lines 75-78, 103). Each of said coils is associated with a corresponding scoring area and thus defines a scoring signal zone (Fig. 2). When said dart is thrown at said dartboard, a scoring signal is generated by said dart entering said signal zone and is transmitted to said scoring system (page 2, lines 20-24, 66-82).

"Regarding the limitation that the induction coil be coreless," the Examiner states:

...the purpose of providing the iron core in the inductor is to concentrate the effect of any magnetic field within the center of the induction coil (within the iron cores). However, as is well known by one of ordinary skill in the art, an inductor is its simplest form is a conductive wire formed in the shape of a loop or coil, and will create the magnetic field inside the coil without the presence of the core.

The Examiner concludes:

Therefore, the inclusion of iron cores in the inductors disclosed by Fuscone is ***not necessary***, as the inductor would still perform the necessary function of creating a magnetic field within the center of the induction coil with or without the iron core, albeit the magnetic field would not have been as concentrated as had the iron core been in place.

The Examiner further stated:

> It the claims are given their broadest reasonable interpretation, the limitation of "a plurality of coreless induction coils with predetermined turns, provided with said frame and connected to said electronic scoring means", wherein "each of said coreless induction coils is associated with a corresponding on [sic] of said scoring areas and defines a scoring signal zone" is met by the invention disclosed by Fuscone, under the assertion that coreless induction coils is a matter of design choice and would have been obvious to one of ordinary skill in the art at the time of the invention.

The Examiner also stated:

> One would have been motivated to remove the core from the induction coil for any application that requires a small amount of induction as in said dartboard to reduce the weight of the apparatus and lower manufacturing costs.

On page 6 of the Final Office Action, under the *Response to Arguments* section the Examiner states:

> This argument of a magnetically insulating board necessitating the iron cores of Fuscone et al. is not persuasive, as Fuscone et al. specifically discloses that "ideally the full board depth should be made magnetically permeable" (P.4, lines 25-26). Thus, it is made clear by Fuscone et al. that the board does not act as an insulator which limits the capability of magnetic flux to penetrate and pass through the board, as alleged by P. 10 of applicant's Remarks.

The undersigned respectfully submits that the Examiner's position remains unsupported by the teachings of Fuscone et al.

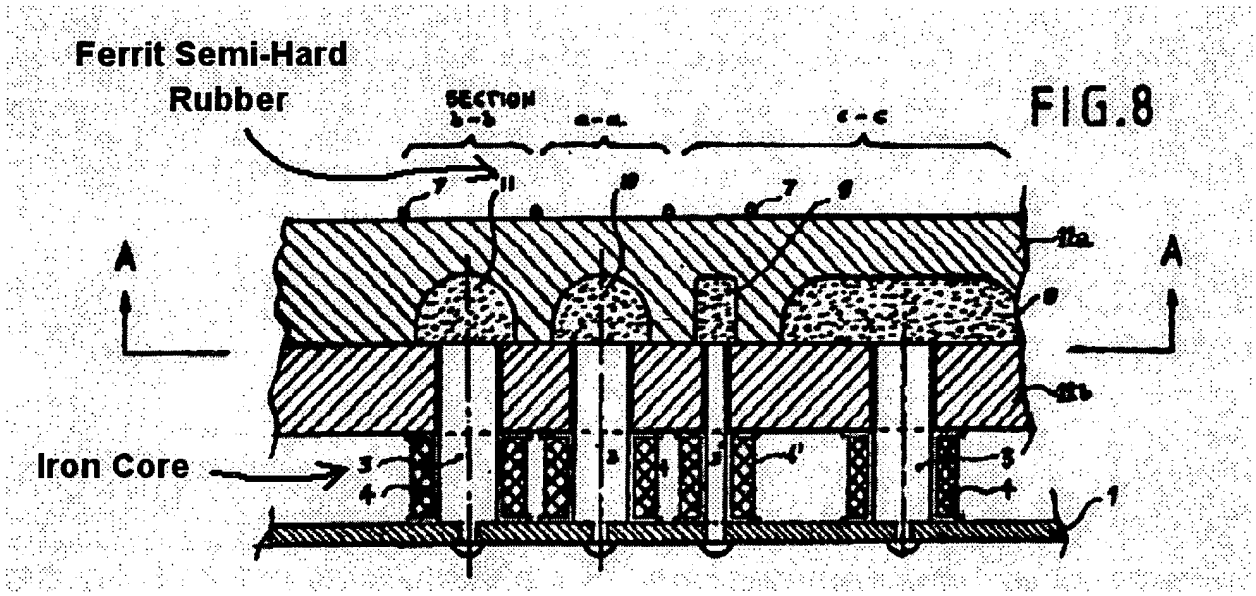
As the Examiner notes, at page 4, lines 25-26 Fuscone et al. teaches:

"Ideally the full board depth should be made magnetically permeable"

In the following lines, i.e., page 4, lines 26-38 Fuscone et al. teaches:

A simplified method is shown in Figures 7 and 8. The board consists of two plates, 12a and 12b, which are bonded together. The target board 12a has recesses 8, 9, 10, 1 (Figure 8 is a cross section, Figure 9 is view A-A) which exemplify the geometry to be applied to all the sections of the Board; into these recesses a ferrite semi-hard rubber or the like substance is placed. The reinforcement board 12b has holes allowing the prolonged cores 3 of the coils to protrude and to touch the magnetic rubber fillings.

Figure 8 of Fuscone et al. is provided as follows:



It is important to recognize that, as the Examiner has noted, Fuscone et al. does teach the "board does not act as an insulator which limits the capability of magnetic flux to penetrate and pass through the board" (Examiner's comments on page 7, lines 1-3 Final Office Action). However, Fuscone et al. teaches that in order to make the board magnetically permeable (in a "simplified" manner at that) it is necessary to embed "ferrite semi-hard rubber or the like substance" in the target board 12a and to extend the (i.e., prolong) the iron cores 3 "to touch the magnetic rubber fillings" as shown in Fig. 8.

In no case or example does Fuscone et al. teach or suggest eliminating the iron cores of that the iron core that the Examiner has concluding are "not necessary."

The actual teachings of Fuscone et al. are opposite to, and do not support, the Examiner's position, that the iron cores are "not necessary" and can be removed as a matter of "design choice."

It is noted that MPEP § 2144.04 provides for aesthetic design changes and for the rearrangement of parts as being "an obvious matter of design choice." (See also MPEP §716.02(f))

This basis of "design choice" is not applicable in the present situation.

MPEP § 2144.04 also provides for the omission of an element and its function, but notes that the applicability of this basis for obviousness is when the prior art provides a teaching that the function of omitted element is not desired or not required.

This basis is not applicable in the present situation inasmuch as Fuscone et al. teaches that the iron cores in the induction coils are required in the disclosed dartboard, and there are no further prior art teachings that support the Examiner's position.

While the Examiner basis his position on the fact that Fuscone et al. teaches that the board can be made magnetically permeable, Fuscone et al. actually teaches extending the iron cores rather than eliminate them and further teaches (i.e. requires) incorporating recesses that are filled with magnetic rubber filling.

It is accordingly submitted that Fuscone et al. teaches against, rather than supports the Examiner's position (of removing the iron cores).

Eliminating the iron cores goes directly against the teachings of Fuscone et al. and would clearly degrade the functioning of Fuscone et al. as understood from the teachings of Fuscone et al.

Under the holding of the Board of Patent Appeals and Interferences in *Ex parte Hartmann*, 186 USPQ 366 (PTO Bd App 1974) such a modification would clearly be improper.

The Examiner's stated motivation - to reduce the weight of the apparatus and lower manufacturing costs – does not compensate for the degradation to the functioning of Fuscone et al, which would result in the proposed modification and does not justify the Examiner proceeding against the clear teachings of Fuscone et al. in the total absence of any further supporting prior art teaching.

In the Advisory Action mailed October 23, 2007 the Examiner references Gordon et al. as analogous art that teaches that iron cores that may be "air wound or, to achieve a higher field, would around a ferromagnetic core."

Gordon et al. is directed to an electro-mechanical detection system in the form of a mat which detects being struck by baseballs, footballs, soccer balls, golf balls and similar balls – and not designed, configured or intended to be used with projectiles that penetrate the mat.

The embodiment which the Examiner has relied upon is discussed at column 4, line 60 through column 5, line 3. This embodiment involves replacing magnetic strips 18 in the embodiment of Figs. 4a-4c with electro magnets.

As described the embodiment of Figs. 4a-4c includes a layer of magnetic strips 18, conductors 22 and wires 16.

In operation, "the deflection of wires 16 in the magnetic field created by magnets 18 causes a small but discernable voltage to be created on wires 22 and 16." (column 4, lines 24-26).

Gordon et al. teaches that the three planes (that include the magnets 18, conductors 22 and wires 16) are preferably separated by no more than 1/16 of an inch. These layers are made from polymeric materials.

The substitution of the electro magnets with the strip magnets 18 seems to require keeping the conductors 22 and wires 16 and the dimensions taught by Gordon et al. Likewise, it appears that the function of the embodiment of the electro magnets would still require a physical deflection as taught by Gordon et al.

The teachings of Gordon et al. are accordingly not a teaching of equivalents which is related or at all applicable to dartboard which: 1) are not configured or designed to have layers that deflect; 2) are relatively thicker that 3/16 of an inch (assuming three layers as taught by Gordon et al.; and 3) are specifically made from materials that allow penetration by darts (e.g. bristle boards).

The equivalents of strip magnets (together with conductors and wires) and electro magnets, the wires and piezo elements of Gordon et al. do not translate to a teaching of equivalents in the art of dartboards.

The Examiner has thus not found or relied upon a art-recognized teaching of equivalents.

<u>The rejection of claim 7 under 35 U.S.C. §103(a)
as being unpatentable over Fuscone et al. in view of Clark.</u>

The Examiner has conceded that Fuscone et al. fails to teach that he wiring of the plurality of coils corresponds to different scoring areas.

The Examiner has accordingly relied upon Clark as teaching a dartboard system that "supports this concept."

The Examiner specifically states that Clark describes the motherboard used to control the electronic scoring and as stating that connections must be connected to the same lines in order for the total number of scoring positions on the dartboard to be accounted for.

The Examiner has taken the position that:

It would have been obvious....to limit the number of inputs required, inputs having the same signal should be tied together into the same input line in order to conserve the number of inputs needed into the motherboard.

Claim 7 requires that a plurality of said coreless coils correspond to different scoring areas representing the same score are wired together before being connected to said electronic scoring means.

Fuscone et al. teaches that a plurality of coils can be used in the same scoring areas as shown in Fig. 2 (See ring areas "a," "b," and "d" which each contain two coils.

Thus, Fuscone et al. fails to teach that the plurality of coils correspond to different scoring areas.

Further, it is submitted that the cited portion of Clark teaches that the "double target segments for the 1, 8, 13 and 19 scoring radials are connected to the output line 6. This means

that the areas representing different scores are wired together rather than areas representing the same score in Clark.

CONCLUSION

For the reasons advanced above, Appellants respectfully contend that the rejection of claims 1-6, 8-11, 14 and 15 as being unpatentable over Fuscone et al. under 35 U.S.C. §103(a) is improper because the examiner has not met the burden of establishing a prima facie case of obviousness of appellant's claimed invention.

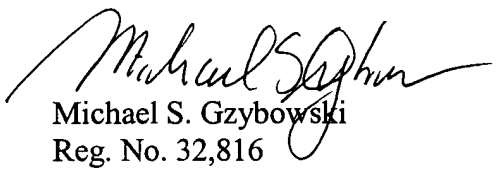
Moreover, for the reasons advanced above, Appellants respectfully contend that the rejection of claim 7 as being unpatentable over Fuscone et al. in view of Clark under 35 U.S.C. §103(a) is improper because the examiner has not met the burden of establishing a prima facie case of obviousness of appellant's claimed invention.

Reversal of the rejections on appeal is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including

extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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CLAIMS APPENDIX

Claim 1 An electronic dart game comprising:

a dart;

a dartboard, provided with

a frame, formed of a plurality of scoring areas by a plurality of radial spiders and circumferential spider which are arranged crossly;

a main body receiving said dart, attached to said frame; and

an electronic scoring means for displaying signals collected from said scoring areas;

a plurality of coreless inductance coils with predetermined turns, provided with said frame and connected to said electronic scoring means through cables;

said dart is provided with a magnetic substance;

each of said coreless inductance coils is associated with a corresponding one of said scoring areas and defines a scoring signal zone; and

a scoring signal is generated by said dart entering said scoring signal zone, said signal is transmitted to said electronic scoring means.

Claim 2 An electronic dart game according to claim 1, wherein said plurality of coreless inductance coils are provided with predetermined shape to be engaged with said scoring areas.

Claim 3 An electronic dart game according to claim 2, wherein cross-section of each turn of said coreless inductance coil matches and is smaller than that of said scoring areas.

Claim 4 An electronic dart game according to claim 3, wherein said frame provided with said coreless inductance coils is arranged in front of said main body.

Claim 5 An electronic dart game according to claim 3, wherein said frame provided with said coreless inductance coils is arranged in back of said main body.

Claim 6 An electronic dart game according to claim 3, wherein said frame provided with said coreless inductance coil is arranged in said main body.

Claim 7 An electronic dart game according to claim 3, wherein a plurality of said coreless coils correspond to different scoring areas representing the same score, are wired together before being connected to said electronic scoring means.

Claim 8 An electronic dart game according to claim 1, wherein a point of said dart is provided with a magnetic substance.

Claim 9 An electronic dart game according to claim 8, wherein a slender shaft of said dart is provided with a magnetic substance.

Claim 10 An electronic dart game according to claim 9, wherein said point and slender shaft of said dart are integrated and magnetized simultaneously.

Claim 11 An electronic dart game according to claim 1, wherein said main body of said dartboard is made of bristle, natural fiber, synthetic fiber, plastic or combinations thereof.

Claims 12-13 (Canceled)

Claim 14 An electronic dart game comprising:

a dart;

a dartboard, provided with

a frame, formed of a plurality of scoring areas by a plurality of radial spiders and circumferential spiders which are arranged crossly;

a main body for receiving said dart, attached to said frame; and

an electronic scoring means for displaying signals collected from said scoring areas;

a plurality of coreless inductance coils with predetermined turns, provided with said frame and connected to said electronic scoring means through cables;

said dart is provided with a magnetic substance;

each of said coreless inductance coils is associated with a corresponding one of said scoring means and defines a scoring signal zone; and

a scoring signal is generated by said dart moving through one of said coreless inductance coils, and said signal is transmitted to said electronic scoring means.

Claim 15 An electronic dart game comprising:

a dart;

a dartboard, provided with

a frame, formed of a plurality of scoring areas by a plurality of radial spiders and circumferential spiders which are arranged crossly;

a main body for receiving said dart, attached to said frame; and

an electronic scoring means for displaying signals collected from said scoring areas;

a plurality of coreless inductance coils with predetermined turns, provided with said frame and connected to said electronic scoring means through cables;

said dart is provided with a magnetic substance;

each of said coreless inductance coils is associated with a corresponding one of said scoring means and defines a scoring signal zone; and

an electronic field is generated only when said dart moves through said coreless inductance coils, and said signal is transmitted to said electronic scoring means.

EVIDENCE APPENDIX

1. *Ex parte Hartmann*, 186 USPQ 366 (PTO Bd App 1974)

RELATED PROCEEDINGS APPENDIX

None

likelihood that the mark would "falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols or bring them into contempt or disrepute". We cannot give the term "may" a broad and indefinite meaning so encompassing as to contravene the evidence presented.

[3] Since we find that the evidence presented is persuasive at this time that there is no reasonable likelihood of a false suggestion with a governmental institution or "national symbol", we conclude that the mark should be published in the Official Gazette in accordance with Section 12(a).

Decision

The refusal to register by the Examiner of Trademarks is reversed.

Patent and Trademark Office Board of Appeals

Ex parte Hartmann

Patent issued Nov. 12, 1974
Opinion dated Apr. 26, 1974

PATENTS

1. Words and phrases (§70.)

"Partial drawing" is intentional, positive act over and above any incidental elongation arising from handling of filaments.

2. Patentability — Invention — In general (§51.501)

Patentability — Anticipation — Combining references (§51.205)

References cannot properly be combined if effect would destroy invention on which one of reference patents is based.

3. Claims — Article defined by process of manufacture (§20.15)

Patentability — Subject matter for patent monopoly — Process, product, and apparatus (§51.613)

Product-by-process claim may be used if language is not vague and indefinite.

4. Board of Appeals — Procedure and practice (§19.45)

Patent and Trademark Office Board of Appeals will follow rulings of Court of Customs and Patent Appeals rather than inconsistent portions of Manual of Patent Examining Procedure.

Particular patents — Plastic Film

3,847,729 Hartmann, Deep-Drawable Plastic Composite Comprising Plastic Film on Fibrous Support, claims 1-3 and 5-12 allowed.

Appeal from Group 160.

Application for patent of Ludwig Hartman, Serial No. 3,129, filed January 15, 1970. From decision rejecting claims 1-3 and 5-12, applicant appeals (Appeal No. 141-93). Reversed; McKelvey, Acting Examiner in Chief concurring with opinion.

Johnston, Keil, Thompson & Shurtleff and Herbert B. Keil, both of Chicago, Ill., for applicant.

Before Schneider and Serota, Examiners in Chief, and McKelvey, Acting Examiner in Chief.

Schneider, Examiner in Chief.

This appeal is from the final rejection of claims 1, 2, 3, and 5 to 12. Claim 4 was withdrawn from further consideration as being directed to a nonelected invention.

Claims 1 and 9 are representative:

1. Deep-drawable composite comprising:

a) a plastic film of deep-drawable plastic,

b) a non-woven fleece consisting essentially of partially drawn and further drawable filaments which are drawable upon deep-drawing of the plastic film,

c) said plastic film coating said fleece.

9. Deep-drawable composite comprising:

a) a plastic film of deep-drawable

b) a non-woven fleece consisting essentially of randomly disposed partially drawn and further drawable continuous monofilaments formed by gas stream drawing and collected to form the nonwoven fleece, said continuous monofilaments having an elongation to breakage of about 100-400%, and being bonded together with a binding agent,

c) said plastic coating said fleece.

The references relied on are:

Graham et al.	2,715,591	Aug. 16, 1955
Reynolds	3,158,525	Nov. 24, 1964

Claims 1 and 5 to 8 stand rejected under 35 U.S.C. 102 as anticipated by Graham et al. We will not sustain this rejection. In our opinion these claims are not fully met by Graham et al. The claims recite the filaments as "partially drawn" before being coated with a plastic filament. Not only does Graham et al. not teach this but, as recognized by the Examiner, Graham et al. teach the use of *undrawn* fibers. The examiner's arguments that appellant's claims are sufficiently broad to encompass essentially no partial drawing, or that a routineer would expect some orientation in the fibers from handling are not deemed to be per- [1] suasive. We believe that the routineer would construe "partial drawing" to mean an intentional, positive act over and above any incidental elongation arising out of normal handling of the filaments.

Claims 2, 3 and 9 to 12 stand rejected under 35 U.S.C. 103 as unpatentable over Graham et al. in view of Reynolds. We do not agree with this rejection.

[2] Reynolds teaches neither partial nor complete orientation of filaments in the film matrix. More importantly however, Reynolds cannot properly be combined with Graham et al. relative to the employment of continuous monofilaments, since to do so would destroy that on which the invention of Graham et al. is based, namely, the use of very short fibers. We will not sustain this rejection.

[3] Claims 9 to 12 were further rejected under 35 U.S.C. 112, presumably the second paragraph, as being "improper" product-by-process claims. We do not agree with this rejection.

The issue raised by the examiner is not "whether product-by-process claims are *ever* proper in this or any application, but whether they are proper when the product can be described without reference to the process." (Answer, page 4).

It is apparently the examiner's position that the instant composites can be defined apart from the method by which the fleece thereof is made in view of claim 1. Claim 1, however, is in itself a product-by-process claim in view of the process limitation "partially drawn".

In any event, assuming that the fleece of appellant's composite is capable of being defined apart from the method by which it is made, we nevertheless believe a product-by-process type claim may properly be used by appellant.

We recognize that the M.P.E.P. provides in Section 706.03(e) (3rd Ed., Rev. 39, 1974):

> "Applicant must * * * make a showing that the product cannot be described except by reference to the process of making it. * * * Accordingly both product claims described by characteristics and product-by-process claims concurrently are inconsistent."

Our reviewing Court has made it plain that if an applicant is claiming what he regards as his invention (a point not here in issue), there is only one basic ground for rejecting a claim under the second paragraph of Section 112, namely, the language employed does not set out and circumscribe a particular area sought to be covered with a reasonable degree of precision and certainty. See e.g., In re Moore, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236, 238 (1971); In re Swinehart, 58 CCPA 1027, 439 F.2d 210, 169 USPQ 226, 229 (1971).

Our reviewing Court has also made it plain that:

> "* * * a product-by-process claim, does not inherently conflict with the second paragraph of 35 U.S.C. 112." In re Brown, 59 CCPA 1036, 459 F.2d 531, 173 USPQ 685 (1972).

See also In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). In In re Steppan, 55 CCPA 791, 394 F.2d 1013, 156 USPQ 143 (1967), the Court states:

> "The problem, in essence, is thus one of determining who shall decide how best to state what the invention *is*. By statute, 35 USC 112, Congress has placed no limitations on *how* an applicant claims *his invention*, so long as the specification concludes with claims which particularly point out and distinctly claim that invention."

See also In re Pilkington, 56 CCPA 1237, 411 F.2d 1345, 162 USPQ 145 (1969).

The examiner has not indicated, nor do we find, anything vague and indefinite about the language of claims 9 through 12. Accordingly, we see no basis for rejecting claims 9 through 12 as being drawn to so-called improper product-by-process claims.

[4] We recognize that the position we take is inconsistent with that portion of the M.P.E.P. quoted above. However, we are constrained to follow the ruling of our reviewing court (CCPA) with which the manual is at variance on this point. We will not sustain the rejection.

The decision of the Examiner is reversed.

McKelvey, Acting Examiner in Chief, concurring.

I agree with the disposition of each rejection and all that is stated in the principal opinion. In connection with our decision reversing the examiner's rejection of claims 9 through 12 as being so-called "improper" product-by-process claims, I wish to add the following observations.

In fairness, it must be recognized that in making the rejection, the examiner was following guidelines provided to him via the Manual of Patent Examining Procedure and, specifically, that portion of the Manual quoted in the principal opinion. However, as was pointed out in Ex parte Schwarze, 151 USPQ 426, 1966 C.D. 10 (Bd.App. 1966):

> "The Manual of Patent Examining Procedure merely provides guidelines for examiners in the Patent Office. It does not replace, and is subservient to, applicable statutes, Rules of Practice, and prior decisions."

As I understand today's decision, this Board is holding, in effect, that the portion of the Manual quoted in the principal opinion is inconsistent with 35 U.S.C. 112, second paragraph, and, therefore, does not accurately state the law. With such a holding I am in complete agreement. Based on this decision, it follows that the quoted portion of the Manual is no longer viable. It also follows that an applicant may, if he chooses to do so, claim a composite in terms of a "product-by-process," provided the claim is definite, notwithstanding the fact the product might be capable of being claimed by reference to its characteristics.

Patent and Trademark Office Trademark Trial and Appeal Board

In re Edward Weck & Company, Inc.

Decided Apr. 17, 1975

TRADEMARKS

Marks and names subject to ownership — Descriptive — Particular marks (§67.5081)

"Dermaclip" is merely descriptive of devices for clamping skin together during operation.

Hauck, Ansorge, Begler & Krentz, New York, N. Y., for applicant.

[Editor's Note: This decision was designated by the Board to appear in digest form only.] Application for registration of trademark of Edward Weck & Company, Inc., Serial No. 431,869. Decision of Examiner of Trademarks refusing registration affirmed by decision (Leach, Waldstreicher, and Lefkowitz, Members) holding that applicant's "Dermaclip" is merely descriptive of devices for clamping skin together during operation.